

REMARKS

Applicants have thoroughly considered the Examiner's remarks in the December 18, 2007 Office action and have amended the application to more clearly set forth aspects of the invention. This Amendment A amends claims 1, 10-11, 20-21, and 33-39. No new matter has been added.

Claims 1-39 are thus presented in the application for further examination. Reconsideration of the application as amended and in view of the following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. §101

Claims 1-33 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicants have amended independent claims 1, 10, 11, 20, 21 and 33 such that the claimed invention is directed to the statutory subject matter. For example, amended claims 1, 11 and 21 now recites a "computerized method." Similarly, claims 10, 20, and 30 now recite "a computer storage medium." Hence, Applicants respectfully submit that, in addition to the remarks below, the rejection of claims 1-33 under 35 U.S.C. §101 should be withdrawn.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Authentica, MailRecal Published 2001 ("Authentica reference"). Applicants respectfully submit that the Authentica reference fails to disclose each and every element of the rejected claims.

In order for a reference to anticipate an invention, the reference must "describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1230 (Fed. Cir. 2000). When looking at a reference for anticipation, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim." 868 F.2d, 1226, 1236 (Fed. Cir. 1989). Furthermore, there is "no anticipation 'unless all of the same elements are found in exactly the same situation and united in the same way . . . in a single prior art reference.'" *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894 (Fed. Cir. 1984).

Applicants respectfully submit that the Authentica reference fails to disclose or suggest at least "... associating the policy restrictions with the one or more defined subsets of potential

users; in response to the associating, defining the associated policy restrictions for the one or more defined subset of potential users; receiving a request from a user for using the piece of data, said using comprises at least one of the following: sending the piece of data and receiving the piece of data, said user being determined to belong to the one or more defined subsets of potential users; and in response to the request, automatically applying the defined policy restrictions to the piece of data for the user without an input from the user such that the user uses," as recited in claim 1.

Applicants respectfully submit that the Authentica reference merely discusses the user being able to control what "a recipient can do after they receive the message." Authentica reference, page 1. However, nowhere does the reference discuss or suggest using the subset, such as an email list. Moreover, the Authentica reference fails to disclose or suggest **automatically applying the policy restrictions based on the membership of the user in the subset without the user input** (emphasis added). At this portion of the amendment is supported by specification, paragraph [0032-34]. In other words, the Authentica reference merely describes that a user can set different controls to the data by "selecting/establishing" the desirable restrictions, but nowhere does the reference disclose or suggest the restrictions will automatically be applied based on the membership of the user in a list or subset.

Embodiments of the invention provide efficient and user-friendly setting for applying the restrictions because the user does not need to perform the actions each and every time. Therefore, the Authentica reference squarely teaches away from embodiments of the invention because the application of the restrictions under the Authentica reference requires direct and manual instructions from the user each and every time.

In addition, Applicants respectfully submit that the Authentica reference fails to disclose at least the subject matter claimed in the original claim 3 because being able to allow a user to control the message, such as allow printing, copying, pasting or forwarding a message, etc., actually teaches away from selecting a sender/recipient from a subset, (e.g., a mailing list) to associate a control setting before sending the message out. The Authentica reference requires that the user needs to perform each of the desirable control settings to each of the messages to be sent. Hence, there is no automatic application; the user needs to do all the work.

Hence, amended claim 1 is patentable over the cited reference. In addition, the dependent claims 2 and 4-9 are also patentable for at least the reasons above. Therefore, the rejection of claims 1-2 and 4-9 under 35 U.S.C. §102(b) should be withdrawn.

Similarly, independent claims 10-11, 20-21, and 33 recite similar features as recited in claim 1. In addition, claims 34-39 recite computerized methods or computer storage media for creating policy restrictions to be automatically applied to a piece of data. For example, amended claim 34 recites:

defining one or more subsets of potential users of the piece of data;
creating the policy restrictions for the one or more defined subset of potential users;
receiving a request from a user for using the piece of data, said using comprises at least one of the following: sending the piece of data and receiving the piece of data;
comparing the user with the one or more defined subsets of potential users; and
in response to the comparing, automatically applying the created policy restrictions to the piece of data for the user without an input from the user such that the user uses the piece of data.

Applicants respectfully submit that the features of claims 34-39 are patentable for at least the reasons above. Hence, the rejection of claims 34-39 under 35 U.S.C. §102(b) should be withdrawn.

Applicants submit that the claims are allowable for at least the reasons set forth herein. Applicants thus respectfully submit that claims 1-39 as presented are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

Applicants wish to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the application in condition for allowance.

Serial No. 10/807,063

MS#303575.01 (5217)

The Commissioner is hereby authorized to charge any deficiency or overpayment of any required fee during the entire pendency of this application to Deposit Account No. 19-1345.

Respectfully submitted,

/TAN-CHI YUAN/

Tan-Chi Yuan, Limited Recognition No. L0113
SENNIGER POWERS, LLP
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

RMB/ATY/caw